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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,903	10/21/2003	Mitsuo Yasushi	040894-5969	3921

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EXAMINER

ADAMS, CHARLES D

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,903	Applicant(s) YASUSHI ET AL.	
	Examiner Charles D. Adams	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-21-03 & 5-7-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The subject matter claimed is not contained within a computer readable medium. The subject matter also does not have a tangible result. As such, the claims are non-statutory.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the basis for the search" in line 6, "the basis of the comparison results" in line 8, and "the comparison results" in line 8. There is insufficient antecedent basis for these limitations in the claim.

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Claim 7 recites the limitation "the basis of the comparison results" in line 8 and "the comparison results" in line 8. There is insufficient antecedent basis for these limitations in the claim.

Claim 8 recites the limitation "the basis for the search" in line 7, "the basis of the comparison results" in line 9, and "the comparison results" in line 9. There is insufficient antecedent basis for these limitations in the claim.

The terms "degree of similarity" and "high degree of similarity" in claims 1, 7, and 8 are relative terms that render the claim indefinite. The terms "degree of similarity" and "high degree of similarity" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is uncertain what subject matter a piece of music must possess to have a 'degree of similarity' to a representative piece of music. There is also no threshold set between "high degrees of similarity" and anything that wouldn't meet this requirement.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4, and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ward (US Patent 6,526,411).

As to claim 1, Ward teaches:

Comparing, on the basis of degree of similarity, representative music, which the user has set and serves as the basis for the search, with a plurality of pieces of music, which are search targets (see 4:40-58); and

Selecting, on the basis of the comparison results, at least one piece of music having a high degree of similarity (see 4:40-58).

As to claim 2, Ward teaches wherein the selected piece of music is a plurality of pieces of music (see 4:40-58),

The music searching method further comprising:

Referencing played frequencies, which are associated the selected pieces of music, respectively (see 5:8-13); and

Sorting, on the basis of the played frequencies, the selected pieces of music in ascending order or descending order (see 5:8-13).

As to claim 4, Ward teaches:

Updating the played frequencies each time a piece of music is skipped (see 8:28-35); and

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Sorting, on the basis of the updated played frequencies, the selected pieces of music in ascending order or descending order (see 8:28-35).

As to claim 7, Ward teaches:

A representative music setting unit configured to set representative music serving as a basis for the search (see 4:40-58);

A comparing unit configured to compare, on the basis of degree of similarity, the representative music and a plurality pieces of music, which are search targets (see 4:40-58);

A similar music selecting unit configured to select, on the basis of the comparison results, a plurality of pieces of music having a high degree of similarity (see 4:40-58); and

A list generating unit configured to generate a music list in which the selected pieces of music are sorted in ascending order or descending order on the basis of a played frequency associated with each of the selected pieces of music (see 5:8-13).

As to claim 8, Ward teaches:

Comparing, on the basis of degree of similarity, representative music, which the user has set and serves as the basis for the search, with a plurality of pieces of music, which are search targets (see 4:40-58); and

Selecting, on the basis of the comparison results, at least one piece of music having a high degree of similarity (see 4:40-58).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (US Patent 6,526,411) in view of Seto et al (US Pre-Grant Publication 2002/0041692).

As to claim 3, Ward teaches the method of claim 2.

Ward does not teach updating the played frequencies each time a piece of music is played; and

Sorting, on the basis of the updated played frequencies, the selected pieces of music in ascending order or descending order.

Seto et al. teaches updating the played frequencies each time a piece of music is played (see paragraph [0038]); and

Sorting, on the basis of the updated played frequencies, the selected pieces of music in ascending order or descending order (see paragraph [0038] and Figures 2 and 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ward to include the teaching of Seto et

al., since Seto et al. teaches that “providing a favorite piece of music to a vehicle driver during a driving operation of the vehicle driver, detects favorite information to discriminate favorite tendency of the vehicle driver with respect to the favorite piece of music, analyzes driver's favorite on the basis of the detected favorite information and storing analyzed resultant data, selects the favorite music piece on the basis of the analyzed resultant data, and provides the selected favorite music piece to the vehicle driver” (see paragraph [0010]) “.

As to claim 5, Ward teaches the method of claim 2.

Ward does not teach sorting, on the basis of environment in which the pieces of music are played, the selected pieces of music in ascending order or descending order.

Seto et al. teaches sorting, on the basis of environment in which the pieces of music are played, the selected pieces of music in ascending order or descending order (see Figure 3, “Location” column).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ward by the teaching of Seto et al., since Seto et al. teaches “providing a favorite piece of music to a vehicle driver during a driving operation of the vehicle driver, detects favorite information to discriminate favorite tendency of the vehicle driver with respect to the favorite piece of music, analyzes driver's favorite on the basis of the detected favorite information and storing analyzed resultant data, selects the favorite music piece on the basis of the analyzed

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resultant data, and provides the selected favorite music piece to the vehicle driver" (see paragraph [0010]).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (US Patent 6,526,411) in view of Cluts (US Patent 5,616,876).

Ward teaches the method of claim 1.

Ward does not teach acquiring, from a multi-channel digital broadcast, the pieces of music that serve as search targets.

Cluts teaches acquiring, from a multi-channel digital broadcast, the pieces of music that serve as search targets (see 2:33-48, and 7:56-65).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Ward by the teaching of Cluts, since Cluts teaches that "indeed, it is feasible that this interactive network will have sufficient bandwidth to supply hundreds of channels of programming information, thereby leading to an explosion of programming options available to subscribers" (see 1:40-44).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Adams whose telephone number is (571) 272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles Adams
AU 2164


SAM RIMELL
PRIMARY EXAMINER